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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/163,199	09/30/1998	HITOSHI FUKUSHIMA	04783/026001	9722

7590

09/23/2002

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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 09/23/2002 26

Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.  
09/163,199

Applicant(s)  
Fukushima et al

Examiner  
Maurie G. Baker, Ph.D.

Art Unit  
1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 30, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## THE PERIOD FOR REPLY [check only a) or b)]

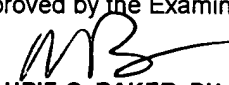
- a) ☒ The period for reply expires THREE months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Aug 30, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Please see attached.

3. ☒ Applicant's reply has overcome the following rejection(s):  
Please see attached.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1, 7, and 8
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
MAURIE G. BAKER, PH.D.  
PATENT EXAMINER  
ART UNIT 1627

**ADVISORY ACTION**  
*Attachment*

1. Applicant's After Final amendment filed August 30, 2002 raises considerable new issues, which would require further search and/or consideration, and does not place the case in better form for appeal or in condition for allowance. Thus the amendment will not be entered.
2. It is noted for the record that the proposed amendments to claim 1 would obviate the *previous* rejection under 35 U.S.C. 112, first paragraph of claims 1 and 7, if the amendments were entered in further prosecution of the instant case. However, the proposed amendments to the claim *raise new issues*, which are elaborated upon below.
3. Applicant proposes to delete the limitation of "a material selected from the group consisting of enzymes, antibodies, artificially synthesized molecules having recognizing functions similar to those of enzymes or antibodies, and mixtures thereof" and add limitations with respect to the way that the solutions are printed (proposed steps (a) and (b)).
4. The deletion of the limitation "a material selected from the group consisting of enzymes, antibodies, artificially synthesized molecules having recognizing functions similar to those of enzymes or antibodies, and mixtures thereof" would raise the issue of prior art (requiring further consideration and new rejections). The previous art of record would now again read on the instant claims. With respect to the newly proposed steps (a) and (b), these limitations clearly would raise new issues requiring further search and/or consideration as they are presented for the first time in this After Final amendment. There is no reason why this amendment was not earlier presented.

5. Also, the limitation in proposed step (b) of "to rest on the microelectrodes", would raise new issues requiring further consideration under 35 USC 112, first and second paragraphs. The limitation is confusing, and appears to lack support in the instant specification.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and alternate Fridays.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached on (703) 306- 3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
September 19, 2002



MAURIE GARCIA BAKER, Ph.D.  
PATENT EXAMINER